



17 AUG 2000

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

=116

Richard A. Dunning
Fish & Richardson, P.C.
225 Franklin Street
Boston, MA 02110-2804

In re Application of
KENNY et al.
Application No.: 09/194,875
PCT No.: PCT/EP97/02888
Int. Filing Date: 04 June 1997
Priority Date: 04 June 1996
Attorney Docket No.: 07217/012001
For: ELECTRONIC DEVICE

:
:
:
: DECISION ON PETITION
:
: UNDER 37 CFR 1.47(a)
:
:

This decision is in response to "RENEWED PETITION UNDER 37 CFR 1.47(a) and For Two-Month Extension of Time" filed 18 May 2000. In a decision dated 13 January 2000 the "PETITION UNDER 37 CFR 1.47(a)" filed 21 June 1999 was dismissed because applicant did not provide adequate proof that the inventor refused to execute the application or could not be reached after diligent effort and did not provide the last known address of the missing inventor, Paul Martin Kenny.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. The 13 January 2000 decision indicated that petitioner has satisfied items (1) and (4).

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

"Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the present petition and the accompanying papers reveal that applicant has not satisfied item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Paul Martin Kenny. As stated in the "Verified Statement of Facts under 37 CFR 1.47 by Harry Hutchinson, "[o]n April 18, 2000, I sent to Mr. Paul Kenny a registered letter enclosing a Combined Declaration and Power of Attorney, a stamped and addressed envelope, a first covering letter for Mr. Kenny to sign indicating that Mr. Kenny refuses to sign document . . ." The mailing of the Combined Declaration and Power of Attorney is not considered a complete copy of the application paper (specification, including claims, drawings, and oath and declaration).

For the reasons stated above, it would not be appropriate to accept the application without the signature of Mr. Kenny under 37 CFR 1.47(a) at this time

CONCLUSION

The renewed petition under 37 CFR 1.47(a) is DISMISSED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extension of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



Boris Milef
PCT Legal Examiner
PCT Legal Office



Anthony Smith
Petitions Attorney
PCT Legal Office
Tel: 703-308-6314
Facsimile: 703-308-6459